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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,841	02/02/2007	Edwin Nun	278280US0PCT	5826
22850 7590 07/02/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER CHOI, FRANK I				
ART UNIT 1616		PAPER NUMBER		
NOTIFICATION DATE 07/02/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/551,841

Applicant(s)

NUN ET AL.

Examiner

FRANK I. CHOI

Art Unit

1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 14-40.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Johann R. Richter/
Supervisory Patent Examiner, Art Unit 1616

6/30/10

Continuation of 3. NOTE: The proposed drawings are labeled new sheets not replacement sheets, and, thus, raise the issue of new matter as the label indicates that the proposed drawings are in addition to the original drawings. The proposed amendment is not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. With respect to claims 27-34, 39, 40, the Applicant argues that the surface distinguishes the claims from the prior art. However, the claims are directed to a composition, i.e. a dispersion containing the claimed hydrophobic particles. This raises the issue of indefiniteness and non-statutory subject matter as the Applicant is asserting that where the composition, i.e. the dispersion, is applied distinguishes the composition from the prior art although the surface to which the composition is applied does not change the composition of the claimed dispersion or the physical characteristics of the individual particles in the dispersion. If the Applicant's argument was valid a manufacturer or seller of the claimed composition would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the composition later applies the composition to one of the listed surfaces. Further, the Applicant is asserting that the method steps of using the composition are a limitation of the composition itself whereas 35 USC 101 sets forth the statutory categories of inventions in the alternative only.

Continuation of 11. does NOT place the application in condition for allowance because: The Examiner acknowledges that the phrase "further comprises" is conventional, however, the phrase must be read in context of the claims. In the claims, the application of the composition is specifically limited to the delineated surfaces of which plastic is not an option. Contrary the Applicant's argument, the limitation does not further limit the claim prior claim(s) but adds an additional surface to which the composition or dispersion can be applied. The claim indicates application to a surface, i.e. singular. As such, the claim only permits application to the delineated surfaces in the alternative not in combination. Therefore, the claim 14 does not permit application to a combination of a plastic surface and one of the listed surfaces in claim 14, i.e. the Applicant's interpretation of the "further comprising" limitation as simply requiring that both plastic and one of surfaces listed in claim 14 are present is not within the scope of claim 14 as written. The applicant argues that Nun et al. does not anticipate claim 35 and 36 is not an invention of another because the surface must be stone, concrete, bricks, plaster, sandwich-type plaster board, joints, paper-based wall paper or mineral paint. However, there is nothing in claim 35 and 36 which requires that the surface be as listed. Claims 35 and 36 only require that the composition of claim 27 be applied. The composition of claim 27 is the dispersion it is not the surface. Claim 27 is directed to a composition not to a surface; the surface is a method of use limitation which does not limit the composition as the composition is the dispersion and where the dispersion is applied has no effect on the composition of the dispersion. The rejection of claims 27, 30-36, 39 and 40 over Keller et al. is withdrawn solely because there is insufficient evidence that the particles have an irregular structure ranging from 1 nm to 1000 nm and an elevation aspect ratio of greater than 1. The rejection of claims 27-30, 35, 39 and 40 over JP 8-165208 is withdrawn solely because there is insufficient evidence that the particles have an irregular structure ranging from 1 nm to 1000 nm and an elevation aspect ratio of greater than 1.